REMARKS

Upon entry of the instant amendment, claims 1-6 and 8-9 will remain pending in the above-identified application and stand ready for further action on the merits. [1]

In the instant Amendment, claim 1 has been amended to clarify/recite that "(B)" is "at least one compound selected from tertiary amine oxide compounds and nitrogen-containing aromatic N-oxide compounds."

Accordingly, the present amendment to the claims does not introduce new matter into the application as originally filed. As such entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

Claim Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-3 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by **Kuroda JP'579** (JP 11-349579).

Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kuroda JP'579** as applied to claims 1-3 and 6 above, and further in view of **Venturello US'276** (US 4,562,276).

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kuroda JP'579** as applied to claims 1-3 and 6 above, and further in view of **Hancock US'032** (US 5,367,032).

[1] The Office Action Summary (PTOL-326) of the January 12, 2009 office action, improperly indicates that claims 1-9 are pending, which is incorrect, since claim 7 was canceled in the prior filed Amendment of October 27, 2008. Correction of USPTO records to indicate that claims 1-6 and 8-9 are currently pending is respectfully requested at present.

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kuroda JP'579** as applied to claims 1-3 and 6 above, and further in view of **Venturello EP'976** (EP0 606 976).

Reconsideration and withdraw of each of the above rejections is respectfully requested at present based on the following considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

MPEP § 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

(a) determining the scope and content of the prior art;

(b) ascertaining the differences between the prior art and the claims in issue;

(c) resolving the level of ordinary skill in the pertinent art; and

(d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP § 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

(a) combining prior art elements according to known methods to yield predictable results;

(b) simple substitution of one known element for another to obtain predictable results;

(c) use of known technique to improve similar devices (methods, or products) in the same way;

(d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(e) "obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

(f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP § 2143.03.

Distinctions Over the Cited Art

Independent claim 1 of the instant invention recites as follows (***emphasis added***):

> *A metal catalyst obtained by contacting*
>
> *(A) at least one metal or metal compound selected from*
>
> *i) tungsten compounds composed of tungsten and an element of group IIIb, IVb, Vb, or VIb,*
>
> *ii) molybdenum compounds composed of molybdenum and an element of group IIIb, IVb, Vb, or VIb, and*
>
> *iii) tungsten metal and molybdenum metal;*
>
> ***(B) at least one compound selected from tertiary amine oxide compounds and nitrogen-containing aromatic N-oxide compounds;***
>
> *(C) hydrogen peroxide; and*
>
> *(D) a phosphate compound.*

In contrast to the instantly claimed invention, neither **Kuroda JP'579** nor **Venturello US'276** teach or suggest using "(B) at least one compound selected from tertiary amine oxide compounds and nitrogen-containing aromatic N-oxide compounds" as recited in independent claim 1 of the instant invention.

Likewise, neither **Hancock US'032** nor **Venturello EP'976** teach or suggest using "(B) at least one compound selected from tertiary amine oxide compounds and nitrogen-containing aromatic N-oxide compounds" as recited in independent claim 1 of the instant invention.

Accordingly, the instant invention as claimed is clearly novel over the cited art of record, since the instantly cited art fails to teach or provide for each of limitations recited in instantly pending claims 1-6 and 8-9.

In addition, it is submitted that each of instantly pending claims 1-6 and 8-9 are non-obvious over the cited art of record, since the cited art fails to provide any reason or rationale to those of ordinary skill in the art with that would allow them to arrive at the instant invention as claimed.

Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

Based on the amendments and remarks presented herein, the USPTO is respectfully requested to issue a Notice of Allowance in the matter of the instant application, clearly indicating that each of instantly pending claims 1-6 and 8-9 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: April 1, 2009

Respectfully submitted,

By _____

John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant